

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

Paul E. Jacobs *et al.*

Serial No. 10/718,125

Filed: November 19, 2003

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**For: A PORTABLE DEVICE WITH
VERSATILE KEYBOARD**

Examiner: Duc Q. Dinh

Group No. 2629

DECLARATION UNDER 37 CFR §1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, Marc Hooks, based on information and belief, do hereby declare that:

1. I am a registered patent agent and employed by Qualcomm, Inc.
2. In the course of my employment by Qualcomm, Inc., I was requested to prepare a patent application based on information submitted by the inventors. After receipt of the information and approval for patenting, preparation of the '125 patent application was entered into our docketing system in order that preparation could be scheduled among other applications awaiting to be drafted and taken up in order as other application prosecution work allowed. In due course, I prepared the '125 patent application which was filed on November 19, 2003.
3. During the period between just prior to September 29, 2003 until November 19, 2003, I worked with the inventors and drafted the '125 patent application. During the afore-mentioned time period, I employed reasonable attorney diligence in preparing the application by working reasonably hard on the application during the continuous critical

period. During the critical period, I maintained a reasonable backlog of unrelated cases which I took up in order and carried out expeditiously. During the afore-mentioned time period:

A- I received email from my supervisor Christopher Edwards, attached as Exhibit A hereto, providing information about search result related to the '125 application.

B- I received email from my supervisor Christopher Edwards, attached as Exhibit B hereto, providing information about availability of one of the inventors, Paul Jacobs, for an interview regarding the '125 application.

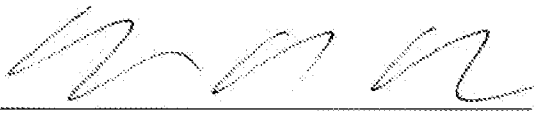
C- I forwarded an email to one of the inventors, Theodore Santos, attached as Exhibit C hereto, requesting information, such as "mechanical drawing particularly focusing more on the slide attaching area" and "flow chart, or decision logic tree, regarding the orientation of the information on the display" for drafting the '125 application.

D- I received an email from one of the inventors, Theodore Santos, attached as Exhibit D hereto, providing information about his availability to review a draft of the '125 application, which I had sent to him for review.

E- I received an email from one of the inventors, Steve Mergenthaler, attached as Exhibit E hereto, providing information about his review a draft of the '125 application, which I had sent to him for review.

4. Exhibits A-E, which relate to the aforementioned attorney diligence until a constructive reduction to practice are hereby incorporated by reference in their entirety herein, correspond to the invention broadly disclosed and claimed in the above-identified patent application. Company proprietary information has been removed from all exhibits.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

 Date: 16 DEC 2006

Marc Hooks

EXHIBIT A

Katbab, Abdollah

From: Hooks, Marc
Sent: Monday, December 11, 2006 3:08 PM
To: Katbab, Abdollah
Subject: 1RE: 040101 AC/DC "Dual-Slide" phone

X-Sender: cedwards@jittlov.qualcomm.com
Date: Wed, 15 Oct 2003 10:28:38 -0700
To: mhooks@qualcomm.com
From: Christopher Edwards <cedwards@qualcomm.com>
Subject: Fwd: Your Ref. COE 0998 / Our Ref. 1759.4001

Date: [REDACTED] 15:01:12 -0700
To: bmilller@qualcomm.com
From: Christopher Edwards <cedwards@qualcomm.com>
Subject: Fwd: Your Ref. COE 0998 / Our Ref. 1759.4001

Ben attached are the search report results. Please note that the report is favorable.

Chris

Chris:

Your Ref. COE 0998 / Our Ref. 1759.4001

With respect to your search request letter of [REDACTED], the search is complete and we need to send you the report.

Attached is a .pdf copy of the report with copies of only the front pages of the references found in the search. (We can send a word copy of the report not including copies of the references, if desired. We can also send you a CD with the report and complete copies of all of the references thereon.)

Do you need a formal letter including the report and complete copies of the references? If so, let us know and we can put it in the mail Wednesday (I will be out of the office tomorrow).

[REDACTED]

[REDACTED]
[REDACTED]
Please acknowledge receipt of this message.

If we can be of further assistance, please let us know.

Thank you for entrusting us with this project.

Randy

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report.pdf

Chris Edwards

L-600E

(858) 845-3487

(858) 658-5703 Fax

EXHIBIT B

Katbab, Abdollah

From: Hooks, Marc
Sent: Monday, December 11, 2006 3:09 PM
To: Katbab, Abdollah
Subject: 2RE: 040101 AC/DC "Dual-Slide" phone

X-Sender: cedwards@jittlov.qualcomm.com
Date: Tue, 21 Oct 2003 12:27:07 -0700
To: Marc Hooks <mhooks@qualcomm.com>
From: Christopher Edwards <cedwards@qualcomm.com>
Subject: Re: Update

OK

At 10:30 AM 10/21/2003, you wrote:
Hi,

Just so you'll have the info.

Paul is OOO until Monday 27th. Secretary said to go ahead and put in request on MM, which I have tentatively done to set up interview for Tues morning.

Marc

Chris Edwards
L-600E
(858) 845-3487
(858) 658-5703 Fax

EXHIBIT C

Katbab, Abdollah

From: Steve Mergenthaler [smergen@qualcomm.com]
Sent: Wednesday, December 13, 2006 7:35 AM
To: Katbab, Abdollah
Subject: Fwd: AC/DC Phone?
Follow Up Flag: Follow up
Flag Status: Orange

X-Sender: mhooks@e2k.qualcomm.com
X-Mailer: QUALCOMM Windows Eudora Version 5.2.0.9
Date: Mon, 03 Nov 2003 13:28:36 -0800
To: esimmons@qualcomm.com, tsantos@qualcomm.com
From: Marc Hooks <mhooks@qualcomm.com>
Subject: AC/DC Phone?
Cc: smergen@qualcomm.com

Good day,

Steve Mergenthaler gave me your names as participants in the subject design.

I am drafting a utility patent application for a phone idea of Steve's and Paul J's. I believe Steve referred to it as the "AC/DC phone". Multi-direction sliding keyboard

I will be "beefing" up the application in the area of the logic involved in orienting the information on the display with regard to the direction of keyboard/screen movement.

I am attempting to have the application in shape for filing by Friday. To that end, I could greatly benefit from (even in very rough form):

1-a mechanical drawing particularly focusing more in the slide attaching area and any comments you feel applicable (I already have third party industrial design drawings)

2-flow chart, or decision logic tree, regarding the orientation of the information on the display in relation to the direction of keyboard/screen movement. Both the QWERTY and the traditional phone key presentation.

High level, rough form, what ever you have, will work fine.

I really appreciate it. Please, also, let me know if nothing available Thanks.

William Marcus Hooks
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Mobile) 1-858-229-4108
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EXHIBIT D

Katbab, Abdollah

From: Hooks, Marc
Sent: Monday, December 11, 2006 3:10 PM
To: Katbab, Abdollah
Subject: 4RE: 040101 AC/DC "Dual-Slide" phone

X-Sender: tsantos@smtphost-co.qualcomm.com
 Date: Tue, 11 Nov 2003 16:52:41 -0700
 To: Marc Hooks <mhooks@qualcomm.com>
 From: Ted Santos <tsantos@qualcomm.com>
 Subject: Re: Patent Application Draft
 Cc: smergen@qualcomm.com

Marc-

I will be in San Diego next week. Can we sit down and review this in person?

Thanks,

Ted

At 01:09 PM 11/10/2003, Marc Hooks wrote:

Good day,

For your review:

Please find attached a draft for patent application for the AC/DC phone. Please note that the application attempts to capture a point of novelty regarding the orientation of the information presented on the display in relation to the direction of keyboard sliding movement.

I'll need to fax the drawings. Is 303-247-5160 a good fax number for you?

William Marcus Hooks
Patent Agent & Strategist
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5775 Morehouse Dr., San Diego CA 92121
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Mobile) 1-858-229-4108
Fax) 1-858-651-5766
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Electronic Communications Privacy Act, 18 U.S.C. 2510-2521 and 2107-2709. If you have received this transmission in error, please immediately notify me by reply e-mail at mhooks@qualcomm.com or by telephone at (858) 658-5932, and destroy the original transmission and its attachments without reading them or saving them to disk. Thank you.

EXHIBIT E

Katbab, Abdollah

From: Hooks, Marc
Sent: Monday, December 11, 2006 3:09 PM
To: Katbab, Abdollah
Subject: 3RE: 040101 AC/DC "Dual-Slide" phone

X-Sender: smergen@m2.qualcomm.com
Date: Wed, 12 Nov 2003 11:48:36 -0800
To: Marc Hooks <mhooks@qualcomm.com>
From: Steve Mergenthaler <smergen@qualcomm.com>
Subject: Re: Patent Application Draft
Cc: tsantos@qualcomm.com, esimmons@qualcomm.com

Hi Marc-

I briefly looked over the document and overall it looks OK to me, although I am by no means a patent expert. The only thing that I'm a little concerned about is the notion from the abstract that there is "a keyboard deployable in multiple directions through a sliding connection to the housing".

Not sure if it's being nit picky, but technically there are two separate keyboards in the assembly (telephone and QWERTY) which are discretely deployable through separate sliding connections. Maybe that's OK from your perspective, but just wanted to be clear. Thanks.

Steve

At 12:56 PM 11/10/2003 -0800, Marc Hooks wrote:

Good day,

For your review:

Please find attached a draft for a patent application for the AC/DC phone. Please note that the application attempts to capture a point of novelty regarding the orientation of the information presented on the display in relation to the direction of keyboard sliding movement.

I'll deliver a hard-copy containing the drawings to your mail box in Bldg-A.

I'm delivering a copy of the doc to Ted S. If there are others that should be in the loop please forward as appropriate or I can send copies if someone can give me their names.

Thanks